

### Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The Office Action dated March 26, 2003, indicated that claims 1, 4 and 16-23 stand rejected under 35 U.S.C. § 102(e) as being anticipated by *White et al.* (U.S. Patent No. 6,069,890); claims 2, 3, 5, 6 and 12 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *White et al.* in view of *Kuthyar et al.* (U.S. Patent No. 5,909,431) and *Shinohara et al.* (U.S. Patent No. 5,351,237); claims 7 and 10 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *White et al.* in view of the *Schulzrinne et al.* article; and claims 8, 9 and 11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over *White et al.* in view of *Kuthyar et al.* and *Shinohara et al.* and further in view of *Schulzrinne et al.*

Applicant respectfully traverses each of the prior art rejections because the Office Action fails to respond to Applicant's previous arguments presented in the Appeal Brief filed on July 12, 2001. The Office Action does not address Applicant's arguments regarding the failure of the '890 reference to teach every limitation of the claimed invention, e.g., designating a telephonic communication addressee. M.P.E.P. § 707.07(f) dictates that the Office Action should take note of the Applicant's previous arguments regarding the impropriety of the asserted references and answer the substance of the arguments. This is consistent with the purpose of aiding the Applicant in judging the propriety of continuing the prosecution, as indicated in 37 C.F.R. § 1.104(a)(2). The Office Action appears to have merely modified the references cited in connection with the Section 103(a) rejections and therefore, does not comply with this requirement. Accordingly, Applicant requests that the rejections be withdrawn.

With respect to the Section 102(e) rejection, the '890 reference fails to teach every limitation of the claimed invention and therefore, the Office Action fails to present a *prima facie* case of anticipation. As discussed previously in the Appeal Brief, the '890 reference which "discloses a system for providing telephone type services," fails to include, for example, limitations requiring that the audio information being analyzed for the determination also designate a

"telephonic communication addressee." There is no allegation in paragraph 3 that the '890 reference includes limitations regarding requiring the audio information being analyzed for the determination also designate a "telephonic communication addressee."

Further, according to the claimed invention, the audio information is analyzed to determine whether to send the audio information to a standard telephonic communication path or to an Internet communication path. In this regard, the claim limitations require that the audio information being analyzed for the determination is also sent down the selected path to establish the communication. In contrast, the '890 reference teaches using a special prefix ("\*82") that is neither used to designate a telephonic communication addressee, nor is sent down the selected path to establish the communication. The '890 reference fails to teach all of the limitations of the claimed invention and in relying on the use of a special prefix ("\*82") teaches away from the claimed invention. Again, the Office Action fails to indicate where the '890 reference teaches these claim limitations including, "the audio information being analyzed for the determination is also sent down the selected path to establish the communication." There is no allegation in paragraph 3 of the Office Action that the '890 reference teaches limitations requiring that "the audio information being analyzed for the determination is also sent down the selected path to establish the communication." Thus, without such prior art correspondence being alleged or otherwise apparent in the cited prior art, no *prima facie* case of anticipation is present and Applicant requests that the rejection be withdrawn.

With specific regard to the Section 103(a) rejections, Applicant respectfully traverses as the Office Action fails to present any evidence of motivation or rationale for combining the cited references. The Office Action fails to present any rationale of how the cited references are to be combined to achieve Applicant's invention. Such rationale is necessary for Applicant to ascertain whether the proposed combination is even consistent with or contradictory to the instant invention. See, e.g., In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

Further, the Office Action fails to present evidence of motivation in support of the modification of the cited '890 reference. Evidence has not been provided of any teaching or suggestion for using the '890 reference in connection different protocols, as claimed in the instant invention, or for modifying the reference to achieve the claimed limitations. Recent case law indicates that evidence of motivation must be specifically identified and shown by some objective teaching in the prior art leading to the modification. "Our court has provided [that the] motivation to combine may be found explicitly or implicitly: 1) in the *prior art references* themselves; 2) in the knowledge of those of ordinary skill in the art that certain *references*, or disclosures in those references, are of special interest or importance in the field; or 3) from the nature of the problem to be solved, 'leading inventors to look to *references* relating to possible solutions to that problem.'" Ruiz v. A.B. Chance Co., 234 F.3d 654, 57 U.S.P.Q.2d 1161 (Fed. Cir. 2000). The Office Action fails to identify evidence of why one skilled in the art would be led to modify the '890 reference, and does not provide any evidence of factual teachings, suggestions or incentives from the prior art that lead to the proposed modification. Applicant accordingly requests that the rejections be withdrawn.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

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